

## **REMARKS**

### **I. Introduction**

Claims 1, 2, 12-16, 20, 21 and 27-29 are pending in the present application. Accordingly, Applicants respectfully request reconsideration of the claims as Applicants' earnest effort places them in condition for immediate allowance.

### **II. Claim Rejections Under 35 U.S.C. § 102**

Claims 1, 2, 12-16, 20, 21, and 27-29 stand rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Eenennaam *et al.* (U.S. Publication No. 2003/0154513). The Examiner states that Eenennaam *et al.* disclose: mixed tocotrienols; ruminants (further anticipating cattle), genetically modified grain cereal crop, corn, and genetically modified oils. (1/6/09 Office Action pp. 2-3). Further, the Examiner states: improved tissue quality claimed in claims 1 and 20, and oxidative stability claimed in claims 2 and 21, are inherent features of tocotrienols; and claim elements of the at least 150 ppm mixed tocotrienol concentration of claims 1 and 50 ppm to 500 ppm tocotrienol concentration range of claims 20, 27 and 29 are inherent feature of corn oil. (1/6/09 Office Action p. 3).

Applicants respectfully traverse the Examiners maintained rejections of claims 1, 2, 12-16, 20, 21, and 27-29. As Applicants have previously set forth for the Examiner, a *prima facie* case of anticipation under § 102 has not been met. The reference cited by the Examiner, Eenennaam *et al.*, does not disclose each and every element as set forth in Applicants' claims as required according to Patent Office practice. MPEP § 2131. In addition, the Examiner's inherency-based rejection for various claim elements is legally insufficient. Simply, inherency may not be established by mere probabilities or possibilities. *See, e.g., Crown Operations Intl. v. Solutia*, 289 F.3d 1367 (Fed. Cir. 2002). Accordingly, Applicants maintain the arguments that the Examiner has not shown that Eenennaam *et al.* disclose all claim elements, including at least, feeding the mixed tocotrienols to animals, obtaining the improved tissue quality from the diet of mixed tocotrienols and identifying Applicants' precise concentrations of mixed tocotrienols as an inherent feature of corn oil.

First, the Examiner failed to show that Eenennaam *et al.* disclose feeding an animal a diet of mixed tocotrienols, as clearly set forth in Applicants' specification as originally-filed. The diet fed to animals requires a mixture of at least three of the four tocotrienols ( $\alpha$ ,  $\gamma$ ,  $\sigma$ , and  $\beta$ -

tocotrienols). Rather, as the Examiner highlights in the Office Action (1/6/09 Office Action p. 5), Eenennaam *et al.* merely disclose an embodiment of increasing throughout an organism – a plant, not an animal – levels of tocopherols and tocotrienols. (Eenennaam *et al.* [0222]). Although the Examiner states that "[a]ny of the plants or parts thereof of the present invention [Eenennaam *et al.*] may be processed to produce a feed, meal, protein, or oil preparation" the disclosure still does not disclose the administration to animals and improvement of tissue quality. To this the Examiner asserts inherency-based rejections.

Second, the Examiner failed to set forth a sufficient inherency rejection under §102, which requires an Examiner to provide rationale or evidence to demonstrate and justify an inherency-based rejection. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) ("In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.") (emphasis added); *see also* MPEP §2112. This initial burden explicitly requires an Examiner to provide extrinsic evidence making clear that the missing descriptive matter is necessarily present in the prior art and would be so recognized by persons of ordinary skill in the art. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Therefore, the mere fact that a certain result or characteristic may be present in a prior art reference is insufficient to establish inherency. *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (emphasis added).

Here, the Examiner has done just this, and nothing more, by merely identifying that Applicants' claimed elements of feeding a diet of mixed tocotrienols to animals to improve tissue quality are found in the prior art reference. Further, the Examiner asserts the specifically claimed concentrations of mixed tocotrienols of Applicants' claims (*i.e.*, ranges from 50 ppm to 500 ppm tocotrienol concentration) are an inherent feature of corn oil. The Examiner failed to show any basis in fact or technical reasoning, specifically failing to show extrinsic evidence, to establish such an inherency-based rejection. Applicants have defined their invention within the precise ranges providing for the improvement of animal tissue quality, clearly identifying the metes and bounds of their invention. To the contrary, Examiner merely suggests all inventive features are inherent, without the showing of any evidence with supporting rationale, as required by Patent Office practice and legal precedence.

Accordingly, Applicants respectfully request the Examiner withdrawn the § 102(e) rejection, as the rejection set forth fails to identify a prior art reference disclosing each and every

claim limitation of Applicants' claimed invention. Therefore, Applicants respectfully request the Examiner place the claims in condition for immediate allowance.

### **III. Double Patenting**

A. Claims 1, 2, 12, 13, 14-16, 20, 21, and 27-29 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-27 of co-pending Application No. 11/153,463. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other as the claims of Application No. 11/153,463 claim a method of improving the tissue quality of an animal, including ruminant animals, using mixed tocotrienols. The Examiner further states the transitional term "comprising" is inclusive and does not exclude additional, unrecited elements or method steps and states the scope of the instant claims is commensurate with the claims of co-pending Application No. 11/153,463. Accordingly the Examiner maintains the rejections of record.

Applicants traverse the double-patenting rejection on at least the same grounds previously made of record. As the Examiner presents provisional double patenting rejections, Applicants may consider terminal disclaimers upon notification of allowable subject matter.

B. Claims 1, 2, 12, 13, 14-16, 20, 21, and 27-29 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of co-pending Application No. 11/530,075. The Examiner states that although the conflicting claims are not identical, they are not patentably distinct from each other because Application No. 11/530,075 claims a method of improving the tissue quality of an animal, including ruminant animals, using mixed tocotrienols. The Examiner further states the transitional term "comprising" is inclusive and does not exclude additional, unrecited elements or method steps and states the scope of the instant claims is commensurate with the claims of co-pending Application No. 11/530,075. Accordingly the Examiner maintains the rejections of record.

Applicants maintain their traversal of the double-patenting rejection on the at least the same grounds previously made of record. As the Examiner presents provisional double patenting rejections, Applicants may consider terminal disclaimers upon notification of allowable subject matter.

#### **IV. Conclusion**

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jill N. Link". The signature is fluid and cursive, with the first name "Jill" and last name "Link" clearly distinguishable.

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